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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,450	12/14/2001	Norman Muttitt	00229.0028.NPUS00	1079
22930	7590	12/01/2005	EXAMINER	
HOWREY LLP C/O IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DR, SUITE 200 FALLS CHURCH, VA 22042-2924				NASH, LASHANYA RENEE
ART UNIT		PAPER NUMBER		
		2153		

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/014,450	MUTTITT ET AL.	
	Examiner LaShanya R. Nash	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This action is in response to an Amendment filed August 24, 2005. Claims 1-28 are presented for further consideration.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In considering the Applicant's arguments the following factual remarks are noted:

- (I)     Applicant contends that Bennett fails to show providing different combinations of multiple pieces of content in a single e-mail to a plurality of patrons.
- (II)    Applicant contends that Mindrum is an entirely different field of invention, and therefore provides no motivation with respect to limiting the amount of content in an e-mail message.

In considering (I), Applicant contends that Bennett fails to show providing different combinations of multiple pieces of content in a single e-mail to a plurality of patrons. Examiner respectfully disagrees. As admitted by Applicant (Remarks page 8), Bennett discloses combining different combinations of content, specifically patron and merchant information, in order to customize and personalize e-mail communications that are subsequently delivered to patrons (paragraph [0078]-[0082]; Figure 3). Applicant's arguments suggest that Bennett fails to show certain features of Applicant's invention, however it is noted that the features upon which Applicant relies (i.e.,

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combining multiple “campaigns” into a single e-mail) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant’s claim language fails to distinguish the type of content information that is combined in order to generate the aforementioned targeted e-mail, from the disclosure of Bennett. Therefore, Examiner maintains that Bennett discloses all limitations of rejected claims, as set forth below in the office action.

In considering (II), Applicant contends that Mindrum is an entirely different field of invention, and therefore provides no motivation with respect to limiting the amount of content in an e-mail message. Examiner respectfully disagrees. In this case, In response to applicant's argument that Mindrum is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Specifically, Mindrum relates to electronically dispensing targeted merchant related content (i.e. coupons) that are determined to be specifically related to a patron (i.e. product purchased by patron), (columns 2-3). Examiner maintains that this is pertinent to Applicant’s field of invention, and subsequently is an applicable prior art reference. Examiner further asserts that Mindrum was cited only in order to evidence that limiting the amount of content delivered to a patron was well known in the art at the time of

invention, independent of the medium used to transmit this aforementioned content (i.e. e-mail). Therefore, Examiner maintains that rejections as set forth below in the office action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2,7-8,13-14, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al. (US Patent Application Publication 2001/0032137), hereinafter referred to as Bennett.**

In reference to claim 1, Bennett discloses a method for distribution of targeted and highly personalized emails (abstract), which comprises:

- A method implemented by a computer for providing different combinations of multiple pieces of content in a single e-mail to a plurality of patrons, (abstract and paragraph [0008], line 1 to paragraph [0009], line 21), the method comprising:

- Maintaining a database identifying each of the patrons and each patron's corresponding interest, (paragraph [0034], line 1 to paragraph [0036], lines 25 and paragraph [0042], lines 1-17);
- Matching the multiple pieces of content to each of the patrons based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9);
- Generating by the computer (i.e. clearinghouse; Figure 1-item 24) the single e-mail for each of the patrons, wherein the e-mail contains the multiple pieces of content; and delivering the e-mail to each of the patrons, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 7, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for providing different combinations of multiple pieces of content in a single e-mail to a plurality of patrons (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 1), the system comprising:
  - Means for (Figure 1-item 24) maintaining a database (Figure 1-item 23) identifying each of the patrons and each patron's corresponding interest, (paragraph [0012], lines 1-11; paragraph [0036], lines 1-25; and paragraph [0042], lines 1-17);

- Means for (Figure 1-item 24) matching the multiple pieces of content to each of the patrons based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);
- Means for (Figure 1-item 24) generating the single e-mail (Figure 1-item 27) for each of the patrons, wherein the e-mail contains the multiple pieces of content; and means for delivering the e-mail to each of the patrons, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 13, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for providing multiple pieces of content in a single e-mail (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 1), the system comprising:
- A plurality of patrons, (Figure 1-item 26);
- A and a processor (Figure 1-item 24) programmed to:
  - Maintain a database (Figure 1-item 23) identifying each of the patrons and each patron's corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);

- Match the multiple pieces of content to each of the patrons based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);
- Generate the single e-mail (Figure 1-item 27) for each of the patrons, wherein the e-mail contains the multiple pieces of content; and deliver the e-mail to each of the patrons, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 19, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for providing multiple pieces of content in a single e-mail (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 10), the system comprising:
- A content management subsystem (i.e. Figure 10 items 23 and 232; main database and ready contact), wherein the content management subsystem is adapted to receive content as input and is adapted to deploy the content into a first database, (paragraph [0091], lines 1-9);
- A datamart subsystem (i.e. Figure 10-item 244; campaign filter), wherein the datamart subsystem is adapted to extract content from the first database (Figure 10-item 23) and one or more other databases (Figure 10-item 238 and 240) and

is adapted to match a plurality of patrons to a single piece of content, based on each patron's corresponding interest, (paragraph [0091], lines 9-16);

- A targeted e-mail application subsystem (i.e. Figure 10-item 244; campaign filter), wherein the targeted e-mail application subsystem is adapted to merge each single piece of content matched to each of the plurality of patrons, so as to provide a single e-mail having multiple pieces of content for each of the plurality of patrons, (paragraph [0091], lines 9-16); and
- An e-mail vendor subsystem (Figure 10-item 230; e-mail send queue), wherein the e-mail vendor subsystem is adapted to distribute the targeted e-mail to each of the plurality of patrons, (paragraph [0091], lines 16-35).

In reference to claims 2,8,14, and 20 Bennett shows the target e-mail method and system further comprising prioritizing the multiple pieces of content for placement (i.e. merging) in the e-mail, (paragraph [0086]).

In reference to claims 25 and 27, Bennett shows the method and system comprises maintaining a database identifying patron's behavior (i.e. information storage unit in communication with patron identification device; paragraphs [0037]-[0038]); and the matching further comprising matching the multiple pieces of content to each of the patrons based on the patron's behavior, (paragraphs [0054]-[0073]).

In reference to claims 26, Bennett shows the method wherein the behavior identified includes at least one of flight behavior and website behavior, (i.e. merchant website paragraph [0037]; paragraphs [0054]-[0073]).

In reference to claim 28, Bennett shows the system wherein the datamart subsystem is further adapted to match a plurality of patrons to a single piece of content based on patrons' behavior, (paragraphs [0054]-[0073]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-4, 9-10, 15-16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1,7,13, and 19 above, in view of Mindrum (US Patent 4,723,212), hereinafter referred to as Mindrum.**

In reference to claims 3,9,15, and 21 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising limiting the number of pieces of content to be provided in the e-mail. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of

ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett.

In an analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

In reference to claims 4,10,16, and 22 Bennett shows the target e-mail method and system, further comprising eliminating duplicate pieces of content, (paragraph [0042], lines 1-13).

**Claims 5,11,17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1,7,13, and 19 above, in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura.**

In reference to claims 5,11, and 23 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to improve the organizational arrangement of targeted email content, and thereby increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60).

**Claims 6,12,18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura, and further in view of Mindrum.**

In reference to claims 6,12, and 24 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to

improve the organizational arrangement of targeted email content, and thereby increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60). Bennett and Kamakura fail to show limiting number of pieces of content within the e-mail categories. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett and Kamakura.

In another analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShanya Nash  
Art Unit, 2153  
November 27, 2005



ARIANE ETIENNE  
PRIMARY EXAMINER